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7590 08/09/2005
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| EXAMINER |
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QIN, YIXING

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| ART UNIT | PAPER NUMBER |
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2622

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,303

Applicant(s)

DAVIS ET AL.

Examiner

Yixing Qin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08).
Paper No(s)/Mail Date 3/7/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 1-3 and 11-21 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okimoto (U.S. Patent No. 6,160,631).

1. Claim 1

- Okimoto discloses in Fig. 1 a printing system. Although not explained in detail, it would be inherent for the computers (both local and remote) to have a processor (i.e. a CPU), memory (i.e. RAM/hard disk) and instructions (i.e. code to run a program or application).
- Okimoto discloses in column 5, lines 6-38 a brief overview of their invention. Column 10, lines 22-28 explains in further detail that the print mail transmission utility 31a (**first instance of an application**) is used to transmit a mail to another computer to be printed (can read on being a **print request** since a remote computer is selected to be printed to). Column 10, lines 44-54 details the receiving of the mail (**receive request**) using a print reception utility 31b (**second instance of the application**) and the printing of the mail. Please note in column 5, lines 34-36 that the mail can be printed **automatically**. The Examiner would

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like to note that although a print transmission and reception utilities are used, one of ordinary skill in the art would understand if these two functions were put together into utility, since Okimoto suggests in column 5, lines 64-67 that both computer systems A and B (i.e. items 8 and 22 of Fig. 1) can both perform print transmission and reception. One skilled in the art would appreciate the combination of the two utilities into one since it enables the computers to both send and receive mail to be printed.

- One can see in Fig. 17 that the format of the mail that is transferred (i.e. **native format**).

2. Claim 2

- One can see in Fig. 1 of Okimoto two mail server, whose tasks are to relay the mail messages from one computer to another (i.e. **receive a job and send it to a remote computer**). Also see Okimoto, column 8, lines 41-52 and column 10, lines 38-50.

3. Claim 3

- Okimoto discloses in Figs. 8 and 10 and column 15, lines 21-45 the idea of checking for new mail from a POP server 38 in the mail server and that is repeated at a certain interval (column 15, lines 29-31). The new mail is then sent to the mail reception utility 31b.

4. Claim 11

- As mentioned in claim 1, the transmission of mail to another printer to print a document can read on a **print request** from a source computer (i.e. PC 4 of Fig. 1 of Okimoto).
- As discussed in claim 2 above, Fig. 1 of Okimoto two mail server, whose tasks are to relay the mail messages from one computer to another (i.e. **receive a job and send it to a remote computer**). The mail servers receive essentially a check for new mail command from the destination computer and sends mail to it to be printed. See Okimoto, column 8, lines 41-52 and column 10, lines 38-50. The Examiner would like to note that requests or commands sent from one computer to another are in the form of signals.
- Okimoto discloses in Fig. 11, items S660, S670 and S680 the idea of sending a return mail to a computer that wanted to cancel a job to be printed. Please see column 18, lines 37-52 for further description. This means that a print job result is received (i.e. if job is canceled, printed, etc) and sent to the creator of the cancel job mail (i.e. the source computer).

5. Claim 12

- Okimoto discloses in Fig. 17 a message format for mail. Column 7, lines 10-18 disclose that the header 50b can contain various printing parameters.

6. Claim 13

- Although not explicitly disclosed, one of ordinary skill in the art would understand that data would have to be converted into a suitable print-ready format before they can be printed. The document format, which one can see in item 50c includes a message and attached files, neither of which would be a print ready format.

7. Claims 14 and 15

- Okimoto discloses in column 11, lines 3-5 that the application that issues a print command can be a word processor or a spreadsheet program.

8. Claim 16

- As mentioned before, the Okimoto reference deals with reception of a mail to be printed.
- As discussed in claim 2 above, Fig. 1 of Okimoto two mail server, whose tasks are to relay the mail messages from one computer to another (i.e. **receive a job and send it to a remote computer**). The mail servers receive essentially a check for new mail command from the destination computer and sends mail to it to be printed. See Okimoto, column 8, lines 41-52 and column 10, lines 38-50. The Examiner would like to note that requests or commands sent from one computer to another are in the form of signals. This check for mail command can read on **an enabling signal**.

- One can see that the print job from PC4 in Fig. 1 of Okimoto is being sent to be printed on a remote printer not directly or LAN connected.

9. Claim 17

- As mentioned in claim 2 above, the mail servers act as relay servers and perform all three of the claimed functions since they send and receive mail and can detect enabling signals from computers.

10. Claim 18

- These limitations have been addressed in claim 16 above, where a computer requests new mail from the mail server and the mail server sends the mail to the computer to be printed at an appropriate printer.

11. Claim 19

- These limitations have been addressed in claim 11.

12. Claim 20

- One can see in Fig. 17 of Okimoto the mail structure has envelope and print data.

13. Claim 21

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- Okimoto discloses in Fig. 17 and column 6, lines 58-67 and column 7, lines 1-30 the make-up of the three types of mails. Specifically, 50b of each type of mail contains a message ID identifying the type of the mail that is being sent (i.e. **type of document**). Although this is not in the envelope data, one of ordinary skill in the art would be able to simply move this information into the envelope data area.

14. Claim 23

- Okimoto discloses Figs. 14a and b that print selection occurs to select a desired printer. Also, Okimoto discloses in column 5, lines 64-67 that both computer systems can perform printer selection, which would indicate that a source computer system can select a printer before the destination computer receives the print mail.

15. Claim 24

- Again, from above, one would understand that the destination computer can also select a desired printer.

16. Claim 25

- One can see in Fig. 19 of Okimoto that an Internet printing agent program has a print mail job associated with an user. As shown in claim 23 above, Figs. 14a and b show two different criteria in which to choose a printer. Networked printing environments are known to have users with different privileges and thus would

be obvious to one of ordinary skill in the art at the time of the invention to use an user id (such as a user name) in determining which printers to use.

17. Claim 26

- Networked computers inherently need a network address in order for other components on the network to identify and to communicate with it. Similar to the rejection above to claim 25, a particular computer with a particular network address could only have certain privileges like certain users. Thus it would be obvious to one of ordinary skill in the art at the time of the invention to use an a network address in determining which printers to use.

II. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okimoto (U.S. Patent No. 6,160,631) in view of Lobiondo (U.S. Patent No. 5,287,194).

18. Claim 4

- One can see in Fig. 1 of Okimoto several remote printers and at least one network.
- One can see that, for example, a local PC 4, is connected to remote printers via the internet.

- Although not explicitly stated, a means for detection of connection of a PC and a printer can simply be the installation of a printer driver on the PC to facilitate proper communication with the printer.
- As mentioned in claim 1, a PC would inherently have a processor, a memory and code to execute.
- Okimoto discloses in column 10, lines 50-54 that “[a]ccording to a setting of the user of the computer 10...[one can print to] an appropriate printer 14, 16, or 18.” One of ordinary skill would understand that this can be interpreted as having a list since one would need to choose which printer to print to. Also, one of ordinary skill would understand that if the local PC 4 can have the same capabilities as the remote computer 10, since Okimoto discloses in column 8, lines 1-7 that the various PCs have the same software arrangement.
- As mentioned in claim 1, the transmission of mail to another printer to print a document can read on a **print request**.
- Okimoto does not explicitly disclose the automatic choosing of a printer to print to from a list. However, the secondary reference, Lobiondo, discloses an automated print control system, where an user can send a job to a network server, and automatically have the job be sent to a printer – see Lobiondo (Fig 4 and column 6, lines 50-67 and column 7 lines 1-9). Although a list is not necessarily disclosed, one of ordinary skill would understand that the computer would have a list of the available printers in order to choose an appropriate one.

- Also lists of printers are common in applications. For example, print dialog boxes in common programs such as Internet Explorer or Microsoft Word enables users to see what available local and networked printers are from a dropdown list.
- Both references are in the art of printing documents to a remote location. This will serve as the motivation for the combination of these two references from hereon. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to have printed a job using an automatically selected printer. The motivation would be to have a shorter wait time for a document to be printed.

19. Claim 5

- One can see that a local printer 6 is connected to the PC 4 in Fig. 1 of Okimoto.

20. Claim 6

- Although not explicitly disclosed that the connection between the PC 4 and the printer 6 is on a LAN, it is well known to connect PCs and printers on a LAN, such as seen in item 22 of Fig. 1 of Okimoto.

21. Claim 7

- One can see in Fig. 1 of Okimoto that remote printers 14, 16, and 18 are connected to the PC 4 through remote PCs 10 and 12.

22. Claim 8

- Direct connection of a printer to a PC is well known, even though the remote computers 10-12 are connected to printers on a LAN. It would be obvious to connect those printers like as with PC 4 and printer 6 in Fig. 1 of Okimoto.

III. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okimoto (U.S. Patent No. 6,160,631) in view of Lobiondo (U.S. Patent No. 5,287,194) and further in view of Marbry et al (U.S. Patent No. 5,692,111).

23. Claims 9 and 10

- Again, the idea of lists of printers is well known. However, a tertiary reference, Marbry has been brought in to show printer and group identifiers for printers. One can see in Figs. 2A and 2B of Marbry that there are various printers (identified by name) belonging to groups (also identified by name).

III. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okimoto (U.S. Patent No. 6,160,631) in view of Greenstein (U.S. Patent No. 6,266,692).

24. Claim 22

- Okimoto does not disclose that there is any authentication information stored in the envelope data. However, the secondary reference, Greenstein, discloses in the abstract, lines 1-6 that an email header contains a password so that a

recipient knows the email is not spam. The Examiner is citing this reference just to show that emails are known to have password/authentication information embedded into it. Both references are in the art of using email to communicate over the Internet. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include authentication information

IV. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okimoto (U.S. Patent No. 6,160,631) in view of Marbry et al (U.S. Patent No. 5,692,111).

25. Claim 27

- Again, please refer to the rejection to claim 9 and 10 above. Marbry further discloses in column 3, lines 23-29 that a user can select a printer to print documents to form a list of printers on a network. The print job would obviously be transferred with the selection since the job needs to be printed.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ


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